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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/643,504	08/19/2003	Colin Hendrick	16045-4	5508
28221	7590	12/28/2004	EXAMINER	
DOCKET ADMINISTRATOR LOWENSTEIN SANDLER PC 65 LIVINGSTON AVENUE ROSELAND, NJ 07068			FRANKLIN, JAMARA ALZAIDA	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 12/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/643,504

Applicant(s)

HENDRICK, COLIN

Examiner

Jamara A. Franklin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 June 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/04, 7/04</u> . | 6) <input type="checkbox"/> Other: ____.  |

### **DETAILED ACTION**

Acknowledgment is made of the receipt of the preliminary amendment received on 6/30/04. Claims 1-31 are currently pending.

#### ***Drawings***

1. The drawings were received on 6/30/04. These drawings are acceptable.

#### ***Claim Objections***

2. Claims 5-7, 9, 10, 14, and 24 are objected to because of the following informalities:

in claim 5, line 7, substitute "the" with --a--;

in claim 5, line 10, substitute "a" with --the--;

in claim 5, line 15, insert --an-- between "and" and "indicator";

in claim 6, line 3, substitute "a" with --the--;

in claim 7, line 3, substitute "a" with --the--;

in claim 9, line 3, substitute "a" with --the--;

in claim 10, line 1, substitute "a" with --the--;

in claim 10, line 2, substitute "match" with --comparison--;

in claim 14, line 1, substitute "had" with --has--; and

in claim 24, line 1, substitute "the" with --a-- and substitute "a" with --an--.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 5 recites the phrase "the sleeve" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Appropriate correction is required.

***Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-30 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-32 of copending Application No. 10/638,921. Although the conflicting claims are not identical, they are not

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patentably distinct from each other because both the instant application and the '921 application disclose:

a receptacle for receiving an intelligent ID card, the receptacle electrically communicating with the intelligent ID card by contacts or RF antenna;

a memory to hold stored data representative of features of the authentic user of the card;

a sensor for collecting data representative of features of the current user of the card; and

a microcomputer to compare the stored data with the sensed data to determine whether the current user is the authentic user.

The instant application claims the receptacle includes a cut way for viewing a portion of the ID card.

One of ordinary skill in the art would have readily recognized that a cut-out section would have been beneficial to the instant application to facilitate simple removal of the card from the card holder since the user could then visually locate the edge of the card. Therefore, it would have been obvious, at the time the invention was made, to modify the claims of the instant application for ease of use for the ID card holder user.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 24-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Emmoft et al. (US 6,424,845) (hereinafter referred to as 'Emmof').

Emmof teaches an intelligent ID card holder (hand-held communication device 10) to authenticate a user of an intelligent ID card (smart card 23) and method of using the intelligent ID card holder comprising (col. 1, line 66-col. 2, line 21):

a receptacle including two major surfaces with an opening formed between the two surfaces to accept the intelligent ID card into the sleeve;

a plurality of contacts exposed on the inside of the receptacle to make electrical contact with the intelligent ID card (col. 2, lines 14-17);

flash memory coupled to the microcomputer (transaction processor 20) to hold user feature data;

a user feature sensor (recognition device 14) mounted on the outside of the receptacle and coupled to the microcomputer to authenticate a user;

a programmed microcomputer mounted on or within one of the surfaces to control the intelligent ID card holder, and to compare a user's sensed feature to a stored user feature, wherein a positive comparison enables the intelligent ID card, or communicates authorization to an outside device or process based on the positive comparison (figure 2 and col. 2, line 61-col. 3, line 11);

the holder wherein the user feature sensor is a finger print sensor mounted on the outside of the receptacle and coupled to the microcomputer to authenticate a user;

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the holder wherein the user feature is a chemical sensor mounted on the outside of the receptacle and coupled to the microcomputer to authenticate the user;

the holder further comprising a visual indicator to indicate a positive match;

the holder further comprising an LCD screen (LCD 12) to communicate information to the user;

the holder wherein the LCD screen displays labels in the vicinity of one or more smart keys to show the function of the one or more keys;

the holder wherein the LCD screen has touch sensitive areas and additionally serves as a key pad for user input;

the holder further comprising a radio frequency (RF section) and antenna (antenna 15) to transmit a signal to the outside device;

the holder wherein the signal is a secure code (col. 4, lines 20-22);

the holder wherein the outside device is a door lock;

the holder wherein the outside device is a building security system;

the holder further comprising one or more keys (cursor controls 16 and 17) mounted on the outside of one of the surfaces of the receptacle and coupled to the microcomputer for user input;

the holder further comprising a microphone (microphone 13) on the outside of one of the surfaces of the receptacle and coupled to the microprocessor;

the holder further comprising a universal serial port (USB) connection to another computer;

the holder wherein the intelligent ID card is a smartcard; and

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the method comprising permitting the user to log into a computer system (personal computer 36).

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. Claims 1-6, 9, 10-20, 22, 23, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Emmoft in view of Eisele et al. (US 6,315,207) (hereinafter referred to as 'Eisele').

The teachings of Emmoft have been discussed above.

Emmofit lacks the teaching of the ID card receptacle including a cut away section and the teaching of a battery mounted within the ID card holder.

Eisele teaches an intelligent ID card holder (smart diskette 103) for an intelligent ID card comprising:

a receptacle for receiving the intelligent ID card (card 702) wherein the receptacle includes a cut away section (cut-out 704) for viewing a portion of the ID card (col. 10, lines 59-64); and

a battery (battery 514) mounted within to power components.

One of ordinary skill in the art would have readily recognized that a cut-out section would have been beneficial to the Emmofit invention to facilitate simple removal of the card from



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the card holder since the user could then visually locate the edge of the card. Therefore, it would have been obvious, at the time the invention was made, to modify the teachings of Emmoft with the cut-out section as taught by Eisele for ease of use for the ID card holder user.

Furthermore, one of ordinary skill in the art would have readily recognized that a battery would have been beneficial to the Emmoft invention for providing direct power to the ID card holder so that the ID card holder does not have to rely on outside power sources to function properly. Therefore, it would have been obvious, at the time the invention was made, to modify the teachings of Emmoft with the battery as taught by Eisele to allow the ID card holder to independently power itself.

12. Claims 7, 8, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Emmoft/Eisele as applied to claim 5 above, and further in view of Bjorn et al. (US 6,125,192) (hereinafter referred to as 'Bjorn').

The teachings of Emmoft/Eisele have been discussed above.

Emmofit/Eisele lacks the teaching of the user feature sensor being a camera sensor.

Bjorn teaches a user feature being a camera sensor mounted on the outside of a receptacle and coupled to a microprocessor to authenticate a user (col. 10, lines 46-61); and

wherein the camera is a CCD camera.

One of ordinary skill in the art would have readily recognized that the camera sensor is just one of a variety of sensors that may be utilized to uniquely identify a user. Therefore,

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it would have been obvious, at the time the invention was made, to modify the teachings of Emmoft/Eisele with the camera sensor as taught by Bjorn to facilitate the identification of the user.

### ***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Schaeck et al. (US 6,775,398) teach a method and device for the user-controlled authorization of chip card functions.

McGregor et al. (US 6,816,058) teach a bio-metric smart card, bio-metric smart card reader and method of use.

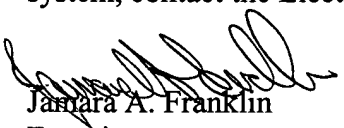
Gutman et al. (US 5,221,838) teach an electronic wallet.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamara A. Franklin whose telephone number is (571) 272-2389. The examiner can normally be reached on Monday through Friday 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jamara A. Franklin  
Examiner  
Art Unit 2876

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December 18, 2004



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